



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/591,289

08/31/2006

Harald Hager

7601/88288

9193

66991

7590

03/03/2010

LAW OFFICE OF MICHAEL A. SANZO, LLC
15400 CALHOUN DR.
SUITE 125
ROCKVILLE, MD 20855

EXAMINER

GILLESPIE, BENJAMIN

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,289	Applicant(s) HAGER ET AL.	
	Examiner BENJAMIN J. GILLESPIE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The current action contains the same ground of rejection as previously set forth in the non-final office action mailed 9/9/2009 and therefore it is proper to make the current action FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. The U.S. Supreme Court supplied seven rationales in *KSR International v. Teleflex Inc.* (550 USPQ2d 1385) that, by following the factual inquiries set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), establish a *prima facie* case of obviousness. The rationales are:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtained predictable results;
- (c) Use of known technique to improve similar devices (, methods, or products) in the same way;
- (d) Applying a known technique to a known device (, method, or product) ready for improvement to yield predictable results;
- (e) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

Art Unit: 1796

- (f) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teaches to arrive at the claimed invention.

5. The examiner notes that the above rationales are merely exemplary. For more information, see MPEP §2141.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Obviousness Rejection I

7. **Claims 76-79** are rejected under 35 U.S.C. 103(a) as being unpatentable over Joachimi et al (PG Pub 2003/0130381) in view of Kondo (U.S. Patent 5,830,568).

8. **Regarding claim 76:** The ground of rejection has been previously set forth in paragraphs 6-10 of the non-final office action mailed 9/9/2009 and is herein incorporated by reference.

Obviousness Rejection II

9. **Claims 61-75 and 80** are rejected under 35 U.S.C. 103(a) as being unpatentable over Joachimi et al (PG Pub 2003/0130381) in view of Kondo (U.S. Patent 5,830,568) and Wissman (PG Pub 2004/0030384).

10. **Regarding claim 61:** The ground of rejection has been previously set forth in paragraphs 12-19 of the non-final office action mailed 9/9/2009 and is herein incorporated by reference.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

12. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

13. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Obviousness-Type Double Patenting Rejection I

Art Unit: 1796

14. **Claims 61-80** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 38-57 of copending Application No. 10/544,041.

15. The rejection has been previously set forth in paragraphs 5-7 of the final rejection mailed 4/2/2009 and is herein incorporated by reference.

16. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. **Claims 61-80** are directed to an invention not patentably distinct from claims 38-57 of commonly assigned 10/544041, similar as noted above.

18. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/544041, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

19. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

20. Applicant's arguments with respect to claims 61-80 have been considered but are not persuasive.

21. Applicants argue the claimed invention is not rendered obvious by the prior art because one of ordinary skill would not arrive at the claimed invention when looking at the combination of Joachimi et al and Kondo.

22. Specifically, while Joachimi et al teach laser weldable compositions comprising IR excitable particles in an amount between 0.001 and 0.1 wt%, applicants argue that in view of Kondo, it would not be obvious to use particles having diameters of 200 nanometers since Kondo teaches these sizes require contents that “is almost entirely outside the range of what... would be appropriate for a laser weldable plastic.”

23. In response, while there is not *substantial* overlap in the ranges of Joachimi et al and Kondo, applicants' readily admit that there is in fact overlap in the weight ranges of Joachimi et al. It would be obvious to utilize the amount of IR excitable particles of Kondo in an amount that overlaps both Joachimi et al and Kondo – i.e. 0.01 wt% (see column 3 lines 41 of Kondo) since this would satisfy the requirements of both references – i.e. it does not exceed the upper limit of IR excitable particle in Joachimi et al, and it falls within the range listed by Kondo which is useful for the relied upon ITO and ATO compounds. The fact that the overlap is not “substantial” does not detract from the fact that there is overlap on applicants' claimed range.

24. Moreover, applicants argue that one of ordinary skill would not look to combine the teachings of Joachimi et al and Kondo in order to maintain transparency since Joachimi et al is

Art Unit: 1796

"primarily concerned with natural-colored and pigmented laser-absorbing molding compositions."

25. In response, while the molded parts of Joachimi et al are to be pigmented and/or colored and therefore will not be ~100% transmissive, the transparency motivation gleaned from Kondo is still relevant since one of ordinary skill would understand the importance of using an additive that does not change the calculated light absorptivity of the final composition. A user may intend on a certain transparency / color based on a desired pigment composition, and if an IR absorptive particle is used that changes these light properties, then the user may have to reformulate the pigment package to compensate for the light characteristics of said IR absorptive particle.

Conclusion

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1796

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN J. GILLESPIE whose telephone number is (571)272-2472. The examiner can normally be reached on 8am-5:30pm.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1796

/Benjamin J Gillespie/
Examiner, Art Unit 1796